

## **REMARKS**

The Applicant has filed the present Response and Amendment in reply to the outstanding Final Official Action of August 30, 2005, and the Applicant believes the Response and Amendment to be fully responsive to the Final Official Action for the reasons set forth below in greater detail.

At the onset, Applicant would like to thank the Examiner for indicating that Claims 1-4, 6-10 and 18-20 are allowed and for indicating that Claims 16 and 25-27 have allowable subject matter and would be allowed if rewritten in independent form, including all of the limitations of the rejected base claim and any intervening claims.

Applicant further would like to thank the Examiner for taking the time to speak with Applicant's representative, Seth Weinfeld, during a telephonic interview on November 30, 2005. During this interview, Applicant's representative pointed to support in the specification for all of the limitations of Claims 28-32. The Examiner agreed to reconsider the § 112 rejection with the primary Examiner. Applicant's representative also discussed a proposed amendment to Claim 21 with the Examiner. No agreement was reached regarding Claim 21.

Additionally, Applicant would like to note that Claims 11 and 21 have been amended herewith. The claims have been amended to recite that the change or modification to the clock is based on "a ratio of the frequency of the main clock signal to the frequency of the wait clock signal". Claims 16 and 25 have been amended to reflect the change in the independent claims, i.e., change antecedent. Claim 2 has been amended to correct a typographical error. No new matter has been added by the aforementioned amendments. For example, support therefor can be found at pages 16-19. Additionally, the amendments are not a new issue, as a similar limitation appears in original Claims 16 and 25.

In the outstanding Final Official Action, the Examiner rejected Claims 28-32 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner avers that the subject matter of “a second single counter configured to count said second clock signal and to control said first counter to stop and restart the counting operation of the first clock signal in response to the second clock signal” is new matter.

Applicant respectfully disagrees with the Examiner’s rejection and traverses with at least the following analysis.

Applicant submits that the specification discloses all of the claim limitations.

For example, a first clock generator is the main clock generator 11, the second clock generator is the wait clock generator 12, the first single counter is the main clock counter 14 and the second signal counter is the wait timer 13. See Figure 2. The wait timer counts the cycles of the wait clock. The wait timer controls the starting of the main clock generator and, in turn, the main clock. See page 13, line 23-page 14, line 3. The wait timer also sends a control signal that stops the main counter. See page 14, lines 10-16. Additionally the wait timer sends a signal which restarts the counting operation from the set count value. See also page 15, line 24-page 18, line 11.

The wait clocks sent while the main clock signal is stopped after the issuance of the wait timer start instruction **are counted for the number WV by the wait timer 13**. It is preferable that the number WV of wait clocks includes a loss for the restarting operation. When counting the wait clocks for the number MW, the **wait timer 13 activates the start signal to the high level** as shown in Fig. 4E, and sends to the CPU 10 and the **main clock generator 11**. (Emphasis Added)

Page 16, lines 15-23.

Therefore, Applicant submits that the limitation is supported by the specification and is not new matter.

In the outstanding Final Official Action, the Examiner rejected Claims 11-15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Kohlschmidt, previously cited, in view of the AAPA. Applicant traverses the rejection with at least the following analysis.

Applicant submits that the hypothetical combination of Kohlschmidt and AAPA fails to teach that the main clock is changed based upon a preset value including a ratio of the frequency of the main clock signal to the frequency of the wait clock signal.

The prior art reference does not calculate the ratio of the frequencies. In contrast, it uses a complex calibration process, during a predetermined calibration period to account for a difference.

During the calibration, a timing relationship is calculated by measuring the clock cycles of each clock source for a given calculation time interval, and this timing relationship is used to adjust the high accuracy clock.

Specifically, prior to entering the sleep mode, a calibration timer is set with a predetermined value representing a calibration time period which will be used to calibrate the slow clock to the high accuracy clock. During this period, a timing relationship between the slow clock and the high accuracy clock is measured. See Col. 6, lines 28-54. **A register is used to accumulate a number of cycles from the high accuracy clock according to the cycles from the slow clock. A formula is then used to calculate the relationship. See Col. 6, lines 60-65.**

The claimed invention simply calculates the frequency ratio and does not require the above calibration process or period. Therefore, the reference fails to teach each and every aspect of the claims. The AAPA does not cure this deficiency.

Accordingly, independent Claim 11 is patentable over the cited combination. Claims 12-15 and 17 are patentable based upon their dependency, whether directly or indirectly, from Claim 11.

The Examiner also rejected Claims 21-24 as being unpatentable over Kohlschmidt in view of Hlasny, United States Patent No. 6,044,282. The Examiner avers that Hlasny teaches using a first and second counting means and that it would have been obvious to one of ordinary skill in the art to incorporate the counting means into the device of Kohlschmidt in order to save the power.

Applicant respectfully disagrees with the Examiner's rejection and traverses with at least the following analysis.

First, the Examiner failed to identify a proper motivation to modify the primary reference, Kohlschmidt. The motivation to modify the primary reference is not clear. To establish obviousness, the Examiner must make a showing of a suggestion or motivation in the art to combine the references. In re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997). "The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence." Teleflex, Inc. v. Ficosa North American Corp., 299 F.3d 1313, 63 U.S.P.Q.2d 1374 (Fed. Cir. 2002) (Citing In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)).

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The motivation

can come from the nature of the problem, the reference, or common knowledge. Id. The Federal Circuit stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct **the suggestion to combine [modify] requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

In re Rouffet, 47 U.S.P.Q.2d 1457-58 (Fed. Cir.1998) (citations omitted, emphasis added).

Obviousness cannot be based upon what a person of ordinary skill in the art could or might try, but rather upon what the prior art would have led a person skilled in the art to do. In re Antonie, 559 F.2d 618 195 U.S.P.Q. 6 (CCPA, 1977).

The Examiner makes no showing of the state of the art at the time of the invention evidencing that those skilled in the art appreciated the problems solved by the present invention. Additionally, the motivation is not suggested by any of the cited references. Specifically, the Examiner avers that the motivation to combine or modify the primary reference is to save the power. However, the primary reference uses registers to accomplish the function of reducing the power, and therefore, there would be no need to include the counters in order to save the power. Additionally, the references do not suggest substituting counters for the registers.

Accordingly, Applicants submit that the Examiner's motivation is not proper.

Second, *pro arguendo*, the cited combination would not teach or render obvious every limitation of the claim. Specifically, the references fail to teach “restarting the counting operation of said main clock of said main clock signal from preset data corresponding to said counted wait clocks of said wait clock signal said preset data includes a ratio of the frequency of the main clock signal to the frequency of the wait clock signal”, as recited in Claim 21 based upon the reasoning set forth above.


Accordingly, independent Claim 21 is patentable over the cited references, as the references, taken alone or in any combination thereof, fail to teach, suggest or render obvious each and every limitation of the claim.

Claims 22-24 are patentable based upon their dependency from Claim 21.

For all of the foregoing reasons, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 28-32 pursuant to 35 U.S.C. § 112, first paragraph. Additionally, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 11-15, 17, 21-24 pursuant to 35 U.S.C. § 103(a).

In conclusion, the Applicant believes that the above-identified application is in condition for allowance and henceforth respectfully solicits the Examiner to allow the application. If the Examiner believes a telephone conference might expedite the allowance of this application, the Applicant respectfully requests that the Examiner call the undersigned, Applicant’s attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,

  
Seth Weinfeld  
Registration No: 50,929

SCULLY, SCOTT, MURPHY & PRESSER, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
516-742-4343  
SW:ae